

REMARKS

Claims 13, 14, and 18-34 have been cancelled, and Claims 1 and 35 have been amended, to place the above-referenced application in condition for allowance. In view of these amendments and the following reasoning for allowance, the applicants hereby respectfully request further examination and reconsideration of the subject application.

The Section 103(a) Rejection of Claims 1-4, 6, 8, 10, 11, 15-17, 29 and 34-37

Claims 1-4, 6, 8, 10, 11, 15-17, 29 and 34-37 were rejected under 35 USC 103(a) as being unpatentable over Holtzman et al. (U.S. Patent Application Publication No. 2002/0062368) in view of Nielsen, U.S. Patent No. 5,948,054. It is contended in the final Office Action that the combined teachings of Holtzman and Nielsen teach all the elements of the rejected claims, and that it would have been obvious to incorporate the Nielsen teachings into Holtzman to produce the applicants' claimed invention. The applicants respectfully disagree.

The applicants claim a feature in independent Claims 1, 29 and 35 whereby messages are tagged when they are posted as being a Question message type or an Answer message type. It is the applicants' position that the Holtzman-Nielsen combination does not teach this feature.

The Examiner states in the Final Office Action that Holtzman does not teach the message type tagging feature. Thus, if the combination teaches this feature it must be found in Nielsen. It is the applicants' position that such a teaching is not expressly or inherently taught in the Nielsen reference.

Granted, it was contended in the Final Office Action that Nielsen taught these features. Specifically, it was stated that:

“The workflow diagram of figure 8A of Nielsen clearly indicates that the message retrieved at step 805 is a question message type. Further, at step 807, the question message types and appropriate HTML tags are stored in a file” (Page 14).

In response it is first pointed out that while the aforementioned workflow diagram mentions messages that are questions, it does not state that they are tagged as such in any manifest way—nor is this taught anywhere else in the reference. The Nielsen invention does not need to tag questions because they are submitted via a web site expressly set up for users to input questions (see Col. 3, lines 54-64). Thus, adding extra data to what is already known by the system to be a question would be extraneous and inefficient. There simply would be no motivation for a person of ordinary skill in the art to do such a thing. The fact that HTML tags are added is not relevant to tagging the question as a question message type. HTML tags are employed to specify how text and other objects are to appear on a web page. This purpose is confirmed in Nielsen at Col. 8, line 57-61, where it is stated:

“Appropriate HTML tags may be added to each file to **improve readability of the new question when displayed** as part of the consultant's personal web page”. *emphasis added*

According, Nielsen cannot be said to either expressly, or owing to the disincentive to add question message tags, inherently, teach the claimed feature of the applicants' invention whereby messages containing questions

are tagged as being Question message types.

It was also contended by the Examiner that Nielsen taught that:

“in col. 3, lines 57-64 it is stated that the customer submitting a question does so by filling in a form, so the customer message **is tagged as a question at least by virtue of being put into a question form**” (Page 14). *emphasis added*

However, this excerpt from Nielsen does not disclose that a tag is associated with each Question message type to indicate that it is a question. It merely indicates that a question form is employed for a customer to submit a question. In fact this teaching supports the applicants' position. If the Nielsen system receives a question from a customer via a web site specifically set up for that purpose on a form specifically design for submitting questions, it is already known the input is a question. Thus, as stated earlier, adding extra data for what is already known by the system to be a question would be extraneous and inefficient. A person of ordinary skill in the art would have no motivation to add the claimed question tag data.

It is noted that the Examiner used the phrase “tagged as a question at least by virtue of being put into a question form” in the foregoing quote. However, it is the applicants' position that data, such as a question, is either tagged, meaning associated with extra data to indicate it is a question—or it is not. Data cannot be “tagged” by virtue of an inference such as it being entered on a form. This is the definition given the term in the specification of the application. As stated on Page 13, paragraph 35:

“Process block 402 indicates that at least some messages in a group are posted by authors with a tag, indicator or

identifier that identifies the message as being of a selected message type. For example, the tag may be of an XML format.

The Nielsen reference also appears to give this same interpretation to the term "tag". The only mention of the word in Nielsen is in reference to HTML tags as evidenced by the statement at Col. 8, lines 57-61:

"In step 807, the method stores the new question in the retrieved file. Appropriate HTML **tags may be added to each file** to improve readability of the new question when displayed as part of the consultant's personal web page".
emphasis added

This is further evidence that a person of ordinary skill in the art would not interpret Nielsen as teaching that its messages are tagged as being a Question message type or an Answer message type by the mere fact that they are known to be questions or answers. The only tags mentioned are HTML tags. Clearly, this use of HTML tags is meant to refer to the addition of new data which is associated with the question file. No additional data is mentioned in regard to identifying the question or answer data as such.

It was further contended in the Final Office Action that:

"the process diagram of Figure 11 of Nielsen teaches that the message sent to a customer is an answer to his question. The message clearly indicates to the customer that this is an answer to his question **at least because it is accompanied by a satisfaction survey asking the customer how he liked the answer**" (Page 14). *emphasis added*

Here again, while the process diagram mentions messages that are answers, it does not state that they are tagged as such. In fact the Examiner even indicates that the customer knows it is an answer because of its context—i.e., because it is accompanied with a satisfaction survey. This does not teach either expressly or inherently that the Nielsen invention associates tag data with answer messages to identify them as such. Nor is such a feature taught anywhere in the reference. This is not surprising since the Nielsen invention does not need to tag answers for reasons similar to why it did not need to tag questions. Namely, the Nielsen scheme sends an email to the person who submitted the question that contains the answer, along with the aforementioned satisfaction survey (see Col. 10, lines 40-45). Thus, it is quite apparent to the customer that the message is an answer. There would be absolutely no reason for a tag to be added to the message data that indicates the message was an answer. Thus, here again adding extra data to what is already known by the system and customer to be an answer would be extraneous and inefficient. There simply would be no motivation for a person of ordinary skill in the art to add such a tag.

The MPEP states at Section 2112, Part IV (Page 2100-54, Rev 2, May 2004) that:

“The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (reversed rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art); *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). “To establish inherency, the extrinsic evidence ‘must make clear

that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson*, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)

The Examiner has not shown that the claimed feature of messages being tagged as being a Question message type or an Answer message type is taught either expressly or inherently in the Nielsen reference. As shown above, the teachings of Nielsen would not suggest to a person of ordinary skill in the art that question and answer messages are tagged as such. Rather the circumstances of the Nielsen invention would suggest just the opposite. There simply is no need for such tags in the Nielsen scheme. In addition, the mention of HTML tags and the absence of any mention of message type tags is further evidence that the latter tags were not envisioned in the Nielsen invention.

In order to deem the applicant's claimed invention unpatentable under 35 USC 103, a prima facie showing of obviousness must be made. To make a prima facie showing of obviousness, all of the claimed elements of an applicant's invention must be considered, especially when they are missing from the prior art. If a claimed element is not taught in the prior art and has advantages not appreciated by the prior art, then no prima facie case of obviousness exists. The Federal Circuit

court has stated that it was error not to distinguish claims over a combination of prior art references where a material limitation in the claimed system and its purpose was not taught therein (*In Re Fine*, 837 F.2d 107, 5 USPQ2d 1596 (Fed. Cir. 1988)).

In this case, neither Holtzman nor Nielsen teach, either expressly or inherently, the applicants' claimed feature of tagging messages when they are posted as being a Question message type or an Answer message type. This feature provides the ability to determine the number of questions and answers posted in a conversation or by an individual without having to analyze the text or circumstances behind the postings. As such a user can quickly assess whether they would be interested in monitoring or joining the discussion, among other things.

Thus, the applicants have claimed a feature not taught in the cited combination, and which has advantages not recognized therein. Accordingly, no prima facie case of obviousness can be established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that the remaining rejected claims are patentable under 35 USC 103(a) over Holtzman in view of Nielsen. As such, it is respectfully requested that the rejection of remaining Claims 1-4, 6, 8, 10, 11, 15-17 and 35-37 be reconsidered based on the non-obvious claim language:

"tagging the messages when they are posted by authoring users as being of one or more selected message types comprising a Question message type indicating that a message is a question and an Answer message type indicating that a message is an answer to a Question message type".

The Section 103(a) Rejection of Claims 5, 7, 9, 12, and 30

Claims 5, 7, 9, 12, and 30 were rejected under 35 USC 103(a) as being unpatentable over Holtzman in view of Nielsen and further in view of Mintz, U.S. Patent No. 6,250,930. It is contended in the Office Action that the combined teachings of Holtzman, Nielsen and Mintz teach all the elements of the rejected claims, and that it would have been obvious to incorporate the Mintz teachings into the Holtzman-Nielsen combination to produce the applicants' claimed invention. The applicants respectfully disagree.

As shown above, the claimed feature whereby the messages are tagged when they are posted as being a Question message type or an Answer message type are not taught in the Holtzman-Nielsen combination. This feature is also not taught in the Mintz reference. Thus, the Holtzman-Nielsen-Mintz combination lacks the aforementioned claimed feature as well.

Accordingly, the applicants have claimed a feature not taught in the cited combination, and which has the aforementioned advantages not recognized therein. As such, no prima facie case of obviousness can be established in accordance with the holding of *In Re Fine*. This lack of prima facie showing of obviousness means that the rejected claims are patentable under 35 USC 103(a) over Holtzman in view of Nielsen and further in view of Mintz. As such, it is respectfully requested that the rejection of remaining Claims 5, 7, 9 and 12 be reconsidered based on the previously-quoted non-obvious claim language.

The Advisory Action

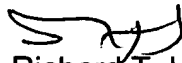
In response to the aforementioned final Office Action, the applicants submitted an after final response requesting reconsideration of the final rejection of the claims. The substance of that response tracked closely to the foregoing arguments for patentability. In addition, an Applicant Initiated Interview Request was filed with the After Final Response. On November 28, 2005, the Examiner contacted the undersigned attorney to discuss the After Final Response. After

discussing the arguments provided in the aforementioned after-final response, the Examiner indicated that the final rejection would stand. Subsequently, the Examiner issued an Advisory Action dated December 2, 2005. In this Action, the Examiner stated that the arguments provided in the After Final Response were not persuasive because the rejected claims include the phrase "tagging or identifying the messages". It was contended that the identifying element was taught in the cited combination. In response, the applicants have filed a Request for Continued Examination along with the present Amendment. In this Amendment, the claims are changed to delete the "or identifying" part of the aforementioned phrase. In addition, Claims 29, 30, 33 and 34 were cancelled. While no admission is made that the rejected claims are actually made obvious by the cited combinations, the applicants have chosen to cancel these claims to further the prosecution of the application and expedite its allowance. As such it is believed the claims are now in condition for allowance for the reasons explained in the foregoing arguments.

Summary

In summary, it is believed that the remaining claims are now in condition for allowance. Accordingly, reconsideration of the rejection of Claims 1-12, 15-17 and 35-37, is respectfully requested. In addition, allowance of all these claims at an early date is courteously solicited.

Respectfully submitted,



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